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| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/525,268 |
| | Filing Date | 08/23/2005 |
| | First Named Inventor | Andreas Poppe |
| | Art Unit | 1713 |
| | Examiner Name | HU |
| Total Number of Pages in This Submission | Attorney Docket Number | PAT-01050 (0906S-401) |

| ENCLOSURES (check all that apply) | | |
|--|--|---|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Reply to Restriction Requirement and Return Postcard |
| Remarks | | The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 23-3425. A duplicate copy of this sheet is enclosed. |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | | |
|--|----------------------------------|--------------------------------|--------------------|
| Firm or Individual name | Harness, Dickey & Pierce, P.L.C. | Attorney Name Anna M. Budde | Reg. No. 35,085 |
| Signature | <i>Anna M. Budde</i> | | |
| Date | May 1, 2006 | | |

| CERTIFICATE OF TRANSMISSION/MAILING | | | |
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| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. | | | |
| Typed or printed name | Anna M. Budde | Express Mail Label No. | EV 853 856 216 US (5/1/2006) |
| Signature | <i>Anna M. Budde</i> | Date | May 1, 2006 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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EV 853 856 216 US



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/525,268
Filing Date: August 23, 2005
Applicant: Andreas Poppe et al.
Group Art Unit: 1713
Examiner: Henry S. Hu
Title: Nanoparticles, Method for Modifying Their Surfaces,
Dispersion of Nanoparticles, Method for the Production
and the Utilization Thereof
Attorney Docket: BASF Docket No. PAT-01050
Harness, Dickey & Pierce Docket No. 906-401

Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action mailed April 10, 2006 in which a restriction requirement was made, Applicants respectfully elect the invention of Group I, to which claims 1-11, 20-24, 31, and 32 are directed.

Applicants respectfully make these elections with traverse of the restriction requirement..

Applicants respectfully traverse the restriction requirement between the inventions of Group I and Group II. Regarding the restriction requirement between the inventions of Group I and Group II, the Office Action states that in Group I the modifier

compound may cover the nanoparticles only physically, which Group II requires a chemical coupling reaction. Applicants respectfully point out that each of modifying groups (A), (B), and (C) is claimed as being "attached covalently to the surface via at least one linking functional group." Thus, the Office's interpretation of the claims of Group I is incorrect; the coverage must involve covalent attachment.

Applicants respectfully traverse the restriction requirement between the inventions of Group I and Group III. The Office Action states that the nanoparticles of claim 1 and the dispersion containing the nanoparticles of claim 1 do not share special technical features under PCT Rules 13.1 and 13.2. In fact, the claims of Group III incorporate all of the limitations of claim 1, the independent claim in Group I. The Office Action alleges that there is no special technical feature because no claim is patentable over the prior art, but this has not been shown and makes the restriction requirement (at best) premature.


Moreover, Applicants respectfully assert that restriction between the combination of Group III and subcombination of Group I requires both two-way distinctness and reasons for insisting on restriction. Two-way distinctness has not been shown, and the discussion in the Office Action of special technical features demonstrates that there is no serious search burden in examining both groups of claims.

Applicants respectfully traverse the restriction requirement between the inventions of Group I and Group IV for the same reasons as they traversed the restriction requirement between the inventions of Groups I and III. The invention of Group IV incorporates all of the features of claim 1. Further, Group I and Group IV are

related as combination/subcombination, and neither two-way distinctness nor serious search burden have been shown.

Group I has been elected with traverse. Applicants respectfully submit that the restriction requirement must be withdrawn of the for the above reasons. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,



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May 1, 2006
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